

## REMARKS

These remarks are responsive to the Office Action dated March 12, 2004 (hereinafter referred to as "the Office Action"). Claims 1-30 are currently pending. Of these claims, only claims 1, 13 and 19 remain rejected. Specifically, the Office Action rejects claims 1, 13 and 19 under 35 U.S.C. 102(e) as being anticipated by United States patent number 6,650,686 issued to Kondo (hereinafter also referred to simply as "Kondo"). The remaining claims are either allowed, or are objected to as being dependent upon a rejected base claim.

As an initial matter, Kondo does not qualify as prior art under 35 U.S.C. 102(e). In relevant part, under 35 U.S.C. 102(e), "a person shall be entitled to a patent unless ... the invention was described in . . . (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent . . .". Kondo is a patent granted on an application for patent by another filed in the United States after the invention by the applicant for patent. Specifically, Kondo was filed in the United States on July 27, 1999. The foreign priority date of Kondo is irrelevant for purposes of 35 U.S.C. 102(e) (see MPEP 2136.03).

MPEP 2136.05 states that the following as an antedating method that is an alternative to submitting a 37 C.F.R. 1.131 antedating affidavit as follows:

The filing date can also be antedated by applicant's earlier foreign priority application ... if 35 U.S.C. 119 is met and the foreign application . . . 'supports' (conforms to 35 U.S.C. 112, first paragraph, requirements) all the claims of the U.S. application ....

In this case, the foreign priority application (Japanese patent application number 200979/1999) was filed on July 14, 1999, thereby providing a date of invention that predates the United States filing date of Kondo. Also, the United States patent application substantively describes the same material described in the priority Japanese patent application. Therefore, if

the United States patent application supports its own claims, the Japanese patent application likewise supports the United States claims. Accordingly, Kondo has been antedated and removed as a 35 U.S.C. 102(e) reference. Withdrawal of the sole remaining rejection is thus respectfully requested.

In case there is any further doubt as to the validity of Kondo as a prior art reference, the following arguments are provided distinguishing Claims 1, 13 and 28 from Kondo. In the portion of Kondo that the Office Action references (column 3, lines 57-67, column 4, lines 9-19, column 19, lines 21-36 and column 20, lines 20-29), there is description that a mobile station obtains reception timing information of neighboring sites (reception timing differences as the differences between the reception timing of a main perch channel and the reception timings of the neighboring sites) from a base station, and then conducts cell search by using the information. Further, there is description that by considering an average reception timing in the past, the search is conducted in the range between the maximum value of the propagation time between a base station and a mobile station and the minimum value of the propagation time.

In contrast, the present invention of claims 1, 13 and 28 determines a degree of how frequent searches for new perch channels are conducted in response to measured receiving quality (for example, received power). This feature of the present invention of claims 1, 13 and 28 is not disclosed in Kondo.

That is, first of all, reception timing (difference) is not receiving quality.

Further, Kondo does not determine a degree of how frequent searches for new perch channels are conducted in response to the reception timing (difference).

Although Kondo discloses that "by considering an average reception timing in the past, search is conducted in the range between the maximum value of the propagation time between a

base station and a mobile station and the minimum value of the propagation time", this only means that the search is conducted from a certain time before the reception timing which is obtained from the reception timing information (reception timing difference), to a certain time after the reception timing. That is, this certain time is constant, and it does not vary in accordance with the reception timing information.

Accordingly, for this additional and independent reason, the 35 U.S.C. 102(e) rejection should be withdrawn. In the event that the Examiner finds remaining impediment to a prompt allowance of this application that may be clarified through a telephone interview, the Examiner is requested to contact the undersigned attorney.

Dated this 25<sup>th</sup> day of June, 2004.

Respectfully submitted,



ADRIAN J. LEE  
Registration No. 42,785  
Attorney for Applicant  
Customer No. 022913  
Phone No.: (801) 533-9800

AJL:ds  
DS0000002070V001